

## REMARKS

Claims 1, 3 and 7 are pending in this Application. Claims 1, 3 and 7 have been amended and claims 2, 4 through 6, 8 and 9 have been cancelled. Care been exercised to avoid the introduction of new matter. Applicants would note that the limitations of claims 2 and 4 have been incorporated into claim 1, and grammatical and formalistic changes made in claims 1, 3 and 7. Applicants submit that the present Amendment does not generate any new matter issue.

### Claim Objection

The Examiner objected to claim 4 identifying a perceived informality. Claim 4 has been cancelled, but the limitation identified by the Examiner has been incorporated into claim 1 and has been changed consistent with the Examiner's suggestion, thereby overcoming the stated basis for the objection. Accordingly, withdrawal of the claim objection is solicited.

**Claims 1 through 9 were rejected under the second paragraph of 35 U.S.C. § 112.**

In the statement of the rejection the Examiner asserted that claims 1 and 2 are indefinite because of the recitation "hard". This rejection is traversed.

Initially, the use of relative terminology does not automatically render a claim indefinite. *Andrew Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988). At any rate, none of the claims now employ the word "hard", thereby overcoming the stated basis for the rejection under the second paragraph of 35 U.S.C. § 112.

Indeed, one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claims 1 through 9 under the second paragraph 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof.

**Claims 1 and 9 where rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Japanese Patent JP 10-308226 (JP ‘226).**

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claims 2 and 4 into claim 1, and canceling claim 9, noting that claims 2 and 4 were not subject to this rejection. Applicants, therefore, submit that the imposed rejection of claims 1 and 9 under 35 U.S.C. § 102 for lack of novelty as evidenced by JP ‘226 is not factually viable and, hence, solicit withdrawal thereof.

**Claim 1 was rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Japanese Patent 2000-67881 (JP ‘881).**

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claims 2 and 4 into claim 1, claims 2 and 4 not being subject to this rejection.

Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by JP ‘881 is not factually viable and, hence, solicit withdrawal thereof.

**Claims 1, 7 and 9 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Nishida et al.**

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claims 2 and 4 into claim 1, claims 2 and 4 not being subject to this rejection.

Applicants, therefore, submit that the imposed rejection of claims 1, 7 and 9 under 35 U.S.C. § 102 for lack of novelty as evidenced by Nishida is not factually viable and, hence, solicit withdrawal thereof.

**Claims 1 through 3 and 9 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Yoshimura et al.**

This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a significant difference between the claimed separator and the separator disclosed by Yoshimura et al. that scotches the factual determination that Yoshimura et al. disclose a separator identically corresponding to that claimed.

Specifically, the limitations of claim 4 have been incorporated into claim 1. Applicants note that claim 4 was not subject to this rejection. Indeed, the separator

according to the present invention contains an intermediate layer which has a minimum micro-Vickers hardness or a minimum Knoop hardness of not less than 8 GPa. No such separator structure with a hard intermediate layer is disclosed or suggested by Yoshimura. Nor can it be said that Yoshimura et al. disclose a separator having an intermediate layer which inherently, i.e., **necessarily**, has a hardness as now recited in claim 1. This is because of the **plethora** of materials disclosed by Yoshimura et al. for first coating layer 62, which appears to be preferably tin (col. 8, lines 10 and 11). As the Examiner should appreciate, inherency requires certainty, **not possibilities**. *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002); *Finnegan Corp. v. ITC*, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). *In re Rijckaert, supra*; *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991).

The bottom line is that Yoshimura et al. do not disclose, do not suggest, and do not inherently form, a separator with an intermediate layer having a minimum hardness as specified in claim 1.

This difference between the claimed separator and the separator disclosed by Yoshimura et al. undermines the factual determination that Yoshimura et al. disclose a separator identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicants, therefore, submit that the imposed rejection of claims 1 through 3 and 9 under 35 U.S.C. § 102 for lack of novelty as evidenced by Yoshimura et al. is not factually viable and, hence, solicit withdrawal thereof.

**Claims 4, 5 and 8 were rejected 35 U.S.C. § 102 for lack of novelty or, alternatively, under 35 U.S.C. § 103 for obviousness predicated upon JP ‘226 or JP ‘881.**

**Claims 4, 5 and 8 were rejected under 35 U.S.C. § 102 for lack of novelty or, alternatively, under 35 U.S.C. § 103 for obviousness predicated upon Nishida et al.**

Each of the above rejections of claims 4, 5 and 8 under 35 U.S.C. § 102 for lack of novelty or alternatively, under 35 U.S.C. § 103 for obviousness predicated upon JP’ 226 or JP ‘881 and Nishida et al. is traversed. Specifically, each of claims 4, 5 and 8 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejections of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by each of JP ‘226, JP ‘881 and Nishida et al. The Examiner’s additional comments with respect to claims 4, 5 and 8 do not cure the previously argued deficiencies of JP ‘226, JP ‘881 and Nishida et al, as none of these references discloses or suggests a separator having a hard intermediate layer as set forth in independent claim 1, noting that the limitations of claims 2 and 4 have been incorporated into claim 1.

Based upon the foregoing Applicants submit that the imposed rejection of claims 4, 5 and 8 under 35 U.S.C. § 102 for lack of novelty or, alternatively, under 35 U.S.C. § 103 for obviousness predicated upon either JP ‘226 or JP ‘881, and the imposed rejection of claims 4, 5 and 8 under 35 U.S.C. § 102 for lack of novelty or, alternatively, under 35 U.S.C.

§ 103 for obviousness predicated upon Nishida et al, are not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 4, 5 and 8 were rejected under 35 U.S.C. § 102 for lack of novelty or, alternatively, under 35 U.S.C. § 103 for obviousness predicated upon Yoshimura et al.**

This rejection is traversed.

Specifically, the Examiner's rejection is predicated upon the theory that the hardness of the intermediate layer of the claimed separator is inherently satisfied by the intermediate layer of the separator disclosed by Yoshimura et al. As previously argued, inherency requires certainty, **not possibilities**. *Crown Operations International Ltd. v. Solutia Inc., supra; Finnegan Corp. v. ITC, supra; In re Robertson, supra, Electro Medical Systems S.A. v. Cooper Life Sciences, Inc., supra; In re Rijckaert, supra; Continental Can Co. USA, Inc. v. Monsanto Co., supra*. The Examiner did not discharge the initial burden of providing a **factual basis** upon which to determine that the intermediate layer 62 of the separator disclosed by Yoshimura et al. **necessarily**, repeat **necessarily**, exhibits a minimum hardness as specified in claim 1. Indeed, as previously pointed out, Yoshimura et al. appears to prefer **tin** as the intermediate layer 62 identified by the Examiner. The Examiner did not factually established that one having ordinary skill in the art, being led by Yoshimura et al. to fabricate a separator in accordance with their disclosure, would have **necessarily** arrived at a separator having an immediate layer satisfying the hardness requirement of independent claim 1. This being the case, there is no burden upon Applicants to proffer any evidence of patentability, because the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention. *In re Deuel, 51 F.3d 1552,*

34 USPQ2d 1210 (Fed. Cir. 1995); *In re Rijckaert, supra*; *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

As to 35 U.S.C. § 103, Applicants would note the Examiner did not identify wherein Yoshimura et al. consider the hardness of layer 62 to be a result effective variable. This being the case, it is legally erroneous to conclude that one having ordinary skill in the art would have been realistically motivated to even focus on the hardness of the intermediate layer as a property of concern. *In re Fritch, supra*, *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968). Indeed, Yoshimura et al. appear to be concerned with the ability of layer 62 to retain electrical conductivity if oxidized. Hardness does not appear to be of any concern.

Based on the foregoing Applicants submit that the imposed rejection of claims 4, 5 and 8 under 35 U.S.C. § 102 for lack of novelty or, alternatively, under 35 U.S.C. § 103 for obviousness predicated upon Yoshimura et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claim 6 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Nishida et al. or Yoshimura et al in view of Fukui et al.**


This rejection is traversed. Indeed, this rejection has been rendered moot by canceling claim 6.

Based upon the foregoing it should be apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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